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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,150	03/12/2001	Seiichi Susaki	566.39866x00	3260

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EXAMINER

HO, THOMAS M

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/803,150

Applicant(s)

SUSAKI ET AL.

Examiner

Thomas M Ho

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 3/12/2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. **Claims 1-18 are pending.**

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In particular applicant has failed to clearly define the context of usage of said invention. Figure 1, as indicated by applicant, would appear to suggest the rating mark as a commodity between investments firms. However, applicant has defined the rating mark as a visible image data used for verification, such as a digital watermark, as is well known in the art. As it stands, the terms, "rating company", "rating mark acquisition request", "rating browser device", and "rating performer device", and "rating target device" are unclear.

For Example, the Applicant has defined in the Abstract the terms “rating browser device” and “rating target device” as such:

“An investor/customer(rating browser device) sends a Web page acquisition request to a private business/owner/firm (rating target device).”

An investor, customer would seem to indicate that a rating browser device indicates a client, a term that although vague, is common and well known in the art. However, the term itself, “Rating browser device” and the web page acquisition request would appear to give weight that a rating browser device is a browser device as is common in the art, such as web browsers Internet Explorer, and Netscape Navigator. However, from this association, and the diagrams, the exact boundaries of this term remain unclear.

Additionally if indeed the Rating browser device is similar to a web browser such as that of Internet Explorer and Netscape Navigator, it remains unclear how this particular aspect of the invention is implemented or devised. In particular, it remains uncertain how the rating browser device deals with and reads the watermarks that have been appended to web page acquisitions requests, and how the appending of the watermark is made to the web page requests as indicated by Applicant on Figure 5, Items S507-509 of the specification. The Examiner notes that this uncertainty arises, with the particular fact that digital watermarks as readily understood in the art are normally appended to image files and can be seen as an indication of authenticity while being very difficult to remove by themselves. While it is certainly well known in the art that

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watermarks may be appended to other files types such as digital music files, general files, and web page requests, these appendages are less common and the exact methodology as to how the watermarks are appended remains uncertain without proper disclosure, even to one of ordinary skill in the art.

Furthermore, the usage of Applicant's invention appears to be placed in the context of an investment guidance system, an authentication system, a watermark vendor, and web browser interface, or some combination thereof. However, the Examiner only infers the specific application of the invention towards each of these roles, as it is not clearly defined. As it stands, the Examiner is unable to determine the exact methodology of usage.

4. Claims 1-18 rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "rating mark" in claims 1-18 is used by the claim to mean, while the accepted meaning is "a mark used to denote a rating". The term is indefinite because the specification does not clearly redefine the term.

The applicant has defined the term rating mark in the specification as such:

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Page 15, paragraph 1:

“A rating mark is a visible image data which provides a validity verification function.”

Applicant further defines a rating mark (page 22, last paragraph) as such:

“The rating mark is an image data with a given design, which allows the rating information and its validity to be visually recognized.”

However, the defining of this term and disclosure of enablement remains deficient. It appears from the specification, that the functions of the rating mark are not merely limited to the authentication functions of a watermark, but also comprising an evaluation result of a company as well, as suggested on page 3 of the Specification. The Applicant, in the background of the invention, appears to use the term “rating” in the context of corporate information and investments. In particular, applicant has stated “A corporate rating agency reviews and evaluates a private business owner or firm from various angles and sells the resultant detailed corporate information to inventors, consumers and firms.” Applicant however, has failed to defined the scope of the rating information, and its composition. The rating mark appears to be a commodity, an authentication function as a watermark, corporate information, and as its name would imply, a rating for a particular company or stock all rolled into one. As it stands, the exact composition of this rating mark, and its boundaries remain unclear.

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Conclusion


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas M Ho whose telephone number is (703)305-8029. The examiner can normally be reached on M-F from 8:30am – 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory A. Morse can be reached at (703)308-4789. The fax phone numbers for the organization where this application or proceeding is assigned are (703)746-7239 for regular communications and (703)746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)306-5484.

TMH

August 7th, 2004



GREGORY MORSE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100